

## REMARKS

Reconsideration of this application in light of the present amendment and remarks is respectfully requested.

Claims 1-34 have been rejected.

Claims 1 and 15 were objected to. Appropriate correction has been proved in accordance with the Examiner's suggestions.

Claims 1, 4, 5, 10-12, 14, 15, 17, 18, 23, 25 and 27-29 have been amended.

Claims 1-34 are pending in this application.

Claims 1-3, 13, 15, 16 and 25 have been rejected under 35 U.S.C. §102(b) as being unpatentable over Almgren et al. (WO 97/32445 hereinafter "Almgren"). This rejection is respectfully traversed.

Independent claims 1, 15 (and 27) have been amended to specify that the "measuring characteristic" of interest in the subscriber unit is the frequency of measurement updates of the subscriber unit when measuring carriers in the frequency band. Support for this can be found in the specification on page 12 lines 16-24. Moreover, the updates are measured dynamically, support for which can be found on page 13 lines 3 to 6.

Applicants' invention relates to selection of a subset of carriers in a given frequency band in response to the measurement update capability in that frequency band of a subscriber unit. For example, a dual-mode subscriber unit may be involved in an active UMTS call and, depending on whether the subscriber unit comprises one or two receivers, the number of carriers included in a GSM neighbor list may be varied. Thus, more GSM carriers are measured if the subscriber unit comprises two receivers than if it comprises only one receiver, as this must be multiplexed between the UMTS and GSM bands.

Using Almgren, the Examiner has interpreted the "characteristic" as mobile speed. In contrast, the independent claims have been amended to reflect that the characteristic is update frequency and not mobile speed. In addition, Almgren does not suggest or disclose update frequency as a measurement characteristic. The Examiner acknowledges this in the Office Action (see item 13, first three lines). Therefore, applicant submits that Almgren is missing this first element of applicant's invention. Moreover, since Almgren is missing the update frequency characteristic, Almgren could not envision the use of update frequency for the selection of a subset of carriers in the frequency band to be measured by the subscriber unit. Therefore, Almgren is also missing this second element of applicant's invention.

As a result, applicants respectfully submit that that amended claims 1 and 15 are patentable and non-obvious over Almgren.

Claims 2, 3 and 13 are dependent on amended claim 1, and therefore include all of the recitations thereof, which are not disclosed or suggested by the references, and are therefore deemed patentable and non-obvious as well for the same reasons.

Similarly, claims 16 and 25 are dependent on amended claim 15, and therefore include all of the recitations thereof, which are not disclosed or suggested by the references, and are therefore deemed patentable and non-obvious as well for the same reasons.

Claims 4-9, 11, 14, 17-24 and 26-34 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Almgren et al. (WO 97/32445 hereinafter "Almgren") in view of ETSI TR 125 922 v3.4.0 2000-12 (hereinafter "3GPP2000"). This rejection is respectfully traversed.

Claims 4, 5, 11 and 14 have been amended to properly follow from amended claim 1.

Claims 17, 18 and 23 have been amended to properly follow from amended claim 15.

Claims 28 and 29 have been amended to properly follow from amended claim 27, which has been amended to include similar recitations as that of amended claim 1.

Almgren has been distinguished previously, and the above arguments concerning Almgren are hereby incorporated by reference.

3GPP2000 discloses that the time needed to perform measurements is based on whether a single-mode user can operate in compressed mode (p.19 sec. 5.1.6.2.1.1). Therefore, it may be implied that measurements are based on whether a single-mode subscriber has the capability of operation in compressed mode. 3GPP2000 is not interested in using dual-mode capabilities as in applicants' invention (see 5.1.5.1 second paragraph), but instead is interested in changing measurement timing using compressed mode for a single-mode user. Therefore, 3GPP2000 teaches away from applicants' invention. In addition, 3GPP2000 does not select a *subset* of carrier frequencies to monitor base upon capability but instead changes the transmission gaps to accommodate the update capability to monitor the entire monitoring set.

Further, 3GPP2000 discloses measurement configuration based upon *previously* received capability information, whereas applicants' amended independent claims determine measurement update frequency *during* carrier measurement. Support for this can be found in the specification on page 12 lines 16 to 17. Specifically, 3GPP2000 relates the base station download of initial capability information during call setup (see page 16 Flows 2 and 3). In contrast, applicant's amended independent claims refers to determining the characteristic *when* measuring (page 12 lines 16 to 17), even during a call (page 12 lines 25 to 26). As a result, applicants' invention provides dynamic updates of performance characteristics (page 13 lines 3 to 6) as opposed to the static approach of 3GPP2000. In view of the above, applicant respectfully submits that 3GPP2000 specifically teaches away from applicant's invention.

As a result, applicants submit that the cited references, in combination or alone, are missing at least the elements of: a) dynamic updates, b) frequency update capability instead of compressed mode capability for a single-mode user, c) selecting a subset of carrier frequencies, and d) selecting a subset of carrier frequencies based upon update capability.

Therefore, applicants respectfully submit that claims 4-9, 11, 14, 17-24 and 26-34 are non-obvious over the cited references.

Moreover, claims 4-9, 11 and 14 are dependent on amended claim 1, previously distinguished, and therefore includes all the recitations thereof, which are not disclosed or suggested by the references, and are therefore deemed allowable as well for the same reasons.

Similarly, claims 17-24 and 26 are dependent on amended claim 15, previously distinguished, and therefore include all the recitations thereof, which are not disclosed or suggested by the references, and are therefore deemed allowable as well for the same reasons.

Claim 27 includes similar recitations as that of claim 1, and is therefore deemed allowable as well for the same reasons.

Claims 28-34 are dependent on claim 27, and therefore include all of the recitations thereof, which are not disclosed or suggested by the references, and are therefore deemed allowable as well for the same reasons.

Accordingly, it is respectfully submitted that this rejection has been overcome.

Claims 10 and 12 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Almgren et al. (WO 97/32445 hereinafter "Almgren") in view of ETSI TR 125 922 v3.4.0 2000-12 (hereinafter "3GPP2000"), and further in view of Lupien (US 5857153). This rejection is respectfully traversed.

Claims 10 and 12 are dependent on amended claim 1, and therefore include all the recitations thereof, which are not disclosed or suggested by the references, and are therefore deemed allowable as well for the same reasons.

Accordingly, it is respectfully submitted that this rejection has been overcome.

The other references of record have been reviewed and applicant's invention is deemed patentably distinct and nonobvious over each taken alone or in combination.

For the foregoing reasons, applicants respectfully request that the above rejections be withdrawn.

Inasmuch as this amendment distinguishes all of the applicants' claims over the prior art references, for the many reasons indicated above, passing of this case is now believed to be in order. A Notice of Allowance is earnestly solicited.

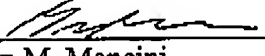
No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

In the event that the Examiner deems the present application non-allowable, it is requested that the Examiner telephone the Applicants' attorney at the number indicated below so that the prosecution of the present case may be advanced by the clarification of any continuing rejection or through an Examiner's amendment.

Authorization is hereby given to charge any fees necessitated by actions taken herein to Deposit Account 50-2117.

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Respectfully submitted,  
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